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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/627,660 | 07/28/2003 | Earl W. Clausen | 032722-571 | 4451 |

46909 7590 04/10/2007
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EXAMINER

RIVELL, JOHN A

ART UNIT PAPER NUMBER

3753

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 04/10/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/627,660 | Applicant(s) CLAUSEN ET AL. | |
| | Examiner John Rivell | Art Unit 3753 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-45 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicants response filed September 2, 2005 has been fully considered. The unusual lengthy delay of this response is sincerely regretted.

This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

Relative to the above, the current submission with respect to (a) and (b) above, e.g. the statement under 37 CFR 3.73(b) filed February 25, 2005, lacks proper indication of the chain of title of the invention of this application. According to the Assignment records of the Patent & Trademark Office, the original inventors assigned the rights of this application to the "Minnesota Mining & Manufacturing Co." who, in turn, assigned rights "Terumo Cardiovascular Systems Corporation". The 3.73(b) statement

of February 25, 2005, lacks any indication of the intermediate assignee. Thus the statement is insufficient at this time.

The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414.

The general allegation that "It is believed that U.S. Patent No. 4,984,972 may be (emphasis here) at least partly inoperative or invalid for the reason that it claims more than there was a right to claim" is an insufficient statement. The inclusion of the phrase "may be" does not render a positive statement as it implies that such facts may not be true.

The reissue oath/declaration filed with this application, and September 2, 2005, is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The general allegation that "The error is characterized by the fact that at least claims 1, 1.9, 28 and 43 may be (emphasis here) invalid over the disclosure of Laing U.S. Patent No. 3,771,910 granted on November 13, 1973 and of record in US. Patent No. 4,984,972" is an insufficient statement. The inclusion of the phrase "may be" does not render a positive statement as it implies that such facts may not be true. Additionally, there is no mention of a specific error for which Reissue is sought.

Claims 1-45 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b). In addition, when any substantive amendment is filed in the reissue application, which amendment otherwise places the reissue application in condition for allowance, a supplemental oath/declaration will be required. See MPEP § 1414.01.

In comparison to the claims as patented, the amendment filed concurrently with this application is improper for several reasons most notably involving the underlining of punctuation marks that are not added to the claim.

In claim 1, line 17, the “;” (semicolon) should not be underlined as this punctuation mark is not being added to the claim. Also, in the last line, the “.” (period at the end of the claim) should not be underlined as this punctuation mark is not being added to the claim.

In claim 19, line 16, the “;” (semicolon at the end of the line) should not be underlined as this punctuation mark is not being added to the claim. Also, in line 18, the “:” (colon or is it a “;” semicolon?) should not be underlined as this punctuation mark is not being added to the claim. Also, in line 22 an additional “.” (period) is underlined as being added to the claim. This conflicts with the last line of the claim and the “.” (period) at the end of the claim which, as underlined, is not being added to the claim.

In claim 38, line 14, the “;” (semicolon or is it a colon?) should not be underlined as this punctuation mark is not being added to the claim. Also, in line 26, the last line of

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the claim, the "." (period) should not be underlined as this punctuation mark is not being added to the claim.

In claim 43, lines 14 and 15, the "," (coma) after "inlet" is not clear. Should this mark be a "," (comma) then it need to be underlined. If so, then the ";" (semicolon) at the end of line 15 should not be underlined as this punctuation mark is not being added to the claim. Also, in line 28, the last line of the claim, the "." (period) should not be underlined as this punctuation mark is not being added to the claim.


The above should not be considered an exhaustive list of any and/or all potential errors in the claims. The claims as amended should be carefully reviewed for compliance with the rules and regulations governing Reissue applications.

Claims 1-45 avoid the art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Rivell whose telephone number is (571) 272-4918. The examiner can normally be reached on Mon.-Thur. from 6:30am-5:00pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Keasel can be reached on (571) 272-4929. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John Rivell
Primary Examiner
Art Unit 3753

j.r.